

REMARKS/ARGUMENTS

The office action dated March 6, 2003 has been carefully reviewed and these remarks are responsive thereto. Claims 14, 26, 27, 38 and 41 have been amended. After entry of the present amendment, claims 14-42 remain pending in this application. Reconsideration and allowance of the instant application are respectfully requested based on the above amendments and the following arguments.

Claims 14-15, 18-19, and 25-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ludwig et al. (U.S. Pat. No. 5,854,893, hereinafter Ludwig). Applicants have amended claims 14 and 26 to more clearly recite that the plurality of tools are web-accessible tools that can be accessed over an IP network, a previously unclaimed feature noted by the examiner in the Final Office Action (OA dated 6-Mar-03, pp. 8-9). Support for the claim amendments may be found in the original application as filed, at least at page 46, lines 3-11.

In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *See* MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Applicants submit that the combination of Ludwig with the level of knowledge of one of ordinary skill in the art at the time the application was filed does not teach or suggest all the claim limitations of amended independent claims 14 and 26. Thus, this rejection is respectfully traversed.

Claims 16-17, 27-31 and 33-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ludwig in view of Walker et al. (U.S. Pat. No. 6,240,396, hereinafter Walker). Claims 27 and 38 have been amended to be consistent with their respective amended independent base claims. Applicants respectfully traverse this rejection based on the following.

Applicants submit that there is no motivation or suggestion to combine the system described in Ludwig with the system described in Walker. Ludwig describes a system for teleconferencing (Ludwig, title), whereas Walker describes a conditional purchase offer system for event tickets (Walker, title). The Office Action states that it would have been obvious to combine Ludwig with Walker because the combination “would have facilitated the haggling type negotiation disclosed by Walker.” However, this is impermissible hindsight, and the Office Action provides no other motivation or suggestion to combine Ludwig with Walker.

The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). Thus, Applicants respectfully submit that there is no motivation or suggestion to combine Ludwig, which discloses a system for teleconferencing, with Walker, which discloses conditional purchase offer system for event tickets. This rejection is respectfully traversed.

Claims 16-17, 27-31 and 33-38 are also allowable for all the reasons given above concerning their respective base claims, which are not cured by the additional reference, and

further in view of their specific recitations that have not been shown to be in (or obvious from) the prior art.

Claims 20-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ludwig in view of Ferguson (U.S. Pat. No. 5,995,951). Applicants submit that there is no motivation or suggestion to combine the system described in Ludwig with the system described in Ferguson. The Office Action states that it would have been obvious to combine Ludwig with Ferguson because Ludwig “would have made the auction of *Ferguson* more exciting.” This is not, however, a suggestion or motivation found in the references, but is instead impermissible hindsight. Many features could be added to any given piece of computer software to make it more “exciting,” but this does not make the addition of each feature obvious.

The Office Action provides no other motivation or suggestion to combine Ludwig with Ferguson. Thus, Applicants submit that claims 20-23 are allowable for all the reasons given above concerning their respective base claims, further in view of their specific recitations that have not been shown to be in (or obvious from) the prior art, and because there is no motivation to combine Ludwig with Ferguson.

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ludwig in view of Microsoft Press Computer Dictionary, Third Edition. Applicant submits that claim 24 is allowable for all the reasons given above concerning its respective base claim, and further in view of its specific recitations that have not been shown to be in (or obvious from) the prior art.

Claim 32 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ludwig in view of Axaopoulos et al. (U.S. Pat. No. 6,286,002). Applicant submits that claim 32 is allowable

for all the reasons given above concerning its respective base claim, and further in view of its specific recitations that have not been shown to be in (or obvious from) the prior art.

Claims 39 and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ludwig in view of Computer Networks, Second Edition, Andrew S. Tannenbaum (hereinafter Tannenbaum). Applicant submits that claim 39 is allowable for all the reasons given above concerning its respective base claims, and further in view of its specific recitations that have not been shown to be in (or obvious from) the prior art.

Applicant has amended independent claim 41 to more clearly recite that the plurality of tools are web-accessible tools are that they are accessible over an IP network, a previously unclaimed feature noted by the examiner in the Final Office Action (OA dated 6-Mar-03, pp. 8-9). Support for the claim amendments may be found in the original application as filed, at least at page 46, lines 3-11. Applicants submit that the combination of Ludwig with Tannenbaum does not teach or suggest all the claim limitations of amended independent claim 41. Thus, this rejection is respectfully traversed.

Claims 40 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ludwig and Tannenbaum in view of Dictionary of Computer and Internet Terms. Applicants submit that claims 40 and 42 are allowable for all the reasons given above concerning their respective base claims, and further in view of their specific recitations that have not been shown to be in (or obvious from) the prior art.

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CONCLUSION

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.


All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same.

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However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,
BANNER & WITCOFF, LTD.

Dated this 6 day of June, 2003

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